

REMARKS/ARGUMENTS

Applicants thank the Examiner for the careful consideration given the present application, and respectfully request favorable reconsideration of the application in view of the comments set forth below.

Election/Restriction

The Office action notes that Applicants previously elected prosecution of Species IV (claims 1, 5, 6, 9, 13-14, 17-22, 26 and 28-30) in response to the original restriction requirement issued on August 16, 2007. However, Applicants respectfully submit that the original restriction requirement identified claim 25 as being withdrawn from further consideration, and included claim 26 in Species IV. Such an amendment is consistent with the other claims elected in response to the original restriction requirement. Accordingly, claim 25 is identified herein as being “Withdrawn” and claim 26 is identified as being an “Original” claim. A telephone call from the Examiner received by Applicants’ undersigned representative on November 20, 2009 confirmed that this correction is proper.

The remaining claims identified by the Examiner as being nonelected claims, namely, claims 2-4 and 36-38, are identified herein as being withdrawn from further consideration.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1, 5-6, 9, 13-14, 35 and 39-40 stand rejected under 35 U.S.C. §103(a) as being Unpatentable over Hower, Jr. *et al.* (US 5,467,434) (hereinafter “Hower”) in view of Garcia *et al.* (US 7,474,423) (hereinafter “Garcia”). However, Applicants respectfully submit that the combination of Hower in view of Garcia fails to teach every feature of the invention as claimed in claims 1, 9 and 35.

Regarding amended claims 1 and 9, neither Hower nor Garcia teaches, suggests or otherwise renders predictable selecting at least one of the final media selection parameters based on the existing information that is typically not used to determine media selection parameters. The Office action correctly notes that Hower does not teach that the print client indicator includes existing information that is not typically used to determine medial selection parameters. It follows that Hower does not teach a selection step based on the existing information that is not

typically used to determine media selection parameters. Further, Garcia fails to teach media selection, media selection parameters, or even a printer for printing on a plurality of different media types. Thus, Applicants respectfully submit that Garcia also fails to teach or suggest selecting at least one of the final media selection parameters based on the existing information that is typically not used to determine media selection parameters.

Further with respect to claims 1 and 9, the combination of Hower and Garcia also fails to teach, suggest or otherwise render predictable that the print client indicator includes existing information in the communication protocol being utilized to send the print job from a print client, wherein the existing information is typically not used to determine media selection parameters. The absence of the claimed print client indicator comprising the existing information typically not used to determine media selection parameters from Hower is correctly noted in the Office action. Applicants respectfully submit that the cited portions of Garcia do not involve a *print client* indicator as claimed, but indicators of the print job *recipient* instead. For example Garcia explains that “the details of the print job such as the *destination* e-mail address(es), the subject of the print job, any message to be delivered to the *job receiver*, etc...” are to be input by the sender. Garcia, col. 5, lines 14-18 (emphasis added). The destination e-mail address and the message to the job receiver both correspond to the recipient, not the print client. And there is no indication in Garcia that the subject of the print job is in any way an indicator of the print client.

Additionally, the other portion of Garcia cited the Office action discloses “a job sending component arranged to transmit a print job comprising at least one print file and an indicator of at least one job receiver to a remote printing server, the indicator comprising an e-mail address corresponding to the job receiver, the job receiver being an entity to accept the print job for printing...” Garcia, col. 10, claim 1. But again, Applicants respectfully submit that this passage involves the transmission of a print job including at least one print file and an indicator of at least one *job receiver* to a remote printing server, and not a print client indicator.

Further with regard to claims 1 and 9, Applicants respectfully submit that the combination of Hower and Garcia also fails to teach, suggest or otherwise render predictable “comparing the print client indicator to a plurality of entries in a mapping module.” As claimed, the print client indicator, which includes existing information that is typically not used to determine media selection parameters, is to be compared to entries in a mapping module to

determine if a matching entry exists. Thus, it is the existing information that is typically not used to determine media selection parameters that is compared. In contrast, the set of rules and the decision tree 76 of Hower involve comparing expressly-defined media selection parameters to the media available to a printer. The media selection parameters compared in Hower are very typically used to determine media selection parameters unlike the claimed print client indicator recited in claims 1 and 9.

For at least the above reasons, the combination of Hower and Garcia fails to teach every limitation found in amended claims 1 and 9 as required to maintain a rejection of those claims under 35 U.S.C. §103(a). Further, since claims 5-8 depend from claim 1 and claims 13-14 depend from claim 9, those claims are also not rendered unpatentable by the combination of Hower and Garcia for the purposes of 35 U.S.C. §103(a).

With regard to claim 35, Applicants respectfully submit that the combination of Hower and Garcia also fails to teach every feature of amended claim 35 for reasons analogous to those set forth above with respect to claims 1 and 9. Specifically, neither Hower nor Garcia teaches, suggests or otherwise renders predictable selecting at least one of the final media selection parameters based on the existing information that is typically not used to determine media selection parameters. The Office action acknowledges this shortcoming of Hower, and Garcia fails to teach media selection, media selection parameters, or even a printer for printing on a plurality of different media types.

Further with respect to claim 35, the combination of Hower and Garcia also fails to teach, suggest or otherwise render predictable that the print client indicator includes existing information within the print job from a print client, wherein the existing information is typically not used to determine media selection parameters. The absence of the claimed print client indicator comprising the existing information typically not used to determine media selection parameters from Hower is correctly noted in the Office action. The destination e-mail address and the message to the job receiver both correspond to the recipient, not the print client. And there is no indication in Garcia that the subject of the print job is in any way an indicator of the print client. Similarly, claim 1 of Garcia cited the Office action also discloses transmission of a print job comprising an indicator of at least one *job receiver* to a remote printing server, the indicator comprising an e-mail address corresponding to the *job receiver*, the *job receiver* being

an entity to accept the print job for printing... *See* Garcia col. 10, claim 1. Thus, this passage also involves an indicator of the **job receiver**, and not a print client indicator.

Further with regard to claim 35, Applicants respectfully submit that the combination of Hower and Garcia also fails to teach, suggest or otherwise render predictable “comparing the print client indicator to a plurality of entries in a mapping module.” As claimed, the print client indicator, which includes existing information that is typically not used to determine media selection parameters, is to be compared to entries in a mapping module to determine if a matching entry exists. Thus, it is the existing information that is typically not used to determine media selection parameters that is compared. The Office action correctly notes that the claimed print client indicator is absent from Hower, but then cites a portion of Hower as teaching the comparison of the claimed print client indicator to the entries in the mapping module. But even considering the media selection parameters of Hower to be the print client indicator for the sake of argument, which Applicants do not concede, Hower involves comparing expressly-defined media selection parameters to the media available to a printer. The media selection parameters compared in Hower are typically used to determine media selection parameters unlike the claimed print client indicator recited in claim 35.

For at least the above reasons, the combination of Hower and Garcia fails to teach every limitation found in amended claim 35 as required to maintain a rejection of that claim under 35 U.S.C. §103(a). Further, since claims 39-40 depend from claim 35, those claims are also not rendered unpatentable by the combination of Hower and Garcia for the purposes of 35 U.S.C. §103(a).

Claim Rejections – 35 U.S.C. § 103(a)

Claims 17-18, 26, 28 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hower in view of Garcia and further in view of Reilly (US 6,502,147) (hereinafter “Reilly”). However, Applicants respectfully submit that the combination of Hower, Garcia and Reilly fails to teach every feature of the claims.

With regard to claims 17 and 28, Applicants respectfully submit that the combination of Hower, Garcia and Reilly fails to teach, suggest or otherwise render predictable a multi-media

printer to render an image from a submitted print job. The absence of such a printer is correctly noted in the Office action. However, Reilly at col. 2, lines 42-45 is cited as teaching a multi-media printer. As explained in the present application, a multi-media printer “may include a combination of printing technologies.” Pg. 1, second to last line. “The multi-media printers are capable of printing on a variety of media types, e.g., paper and film, and also on a variety of media sizes...” Pg., 2, lines 11-13. Thus, the multi-media printer in claims 17 and 28 can be used with a plurality of different media, and/or employ a plurality of different printing technologies. In contrast, the cited portion of Reilly discloses a printer that can be incorporated into the same machine as the print server. There is no indication in Reilly that the printer that can be incorporated into the same machine as the print server is a multi-media printer, and the print server is not a printer for a different medium and/or using a different printing technology.

Further with regard to claims 17 and 28, the combination of Hower, Garcia and Reilly also fails to teach, suggest or otherwise render predictable “a mapping module including a plurality of entries, each of the plurality of entries including at least one print client indicator.” Garcia and Reilly fail to teach such a feature, and the cited portion of Hower fails to teach a plurality of entries each including a print client indicator as claimed. As noted in the Office action, Hower does explain that the parameters for any given profile *could* be organized into any sort of link list(s). It appears from this portion of Hower that each entry of the mapping module is considered by the Examiner to inherently include at least one print client indicator. However, Applicants respectfully submit that a claim limitation can not be inherently present simply because of the mere possibility that it could result from optimization of the prior art when such optimization is not taught.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is

not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). M.P.E.P. §2112, IV.

For at least the above reasons, Applicants respectfully submit that the combination of Hower, Garcia and Reilly fails to teach every limitation found in claims 17 and 28 as required to maintain a rejection of those claims under 35 U.S.C. §103(a). Further, since claims 18-22, 26 and 27 depend from claim 17, and claims 29 and 30 depend from claim 28, those claims are also not rendered unpatentable by the combination of Hower, Garcia and Reilly for the purposes of 35 U.S.C. §103(a).

The remaining claims in the present application are allowable for the limitations therein and for the limitations of the claims from which they depend.

In light of the foregoing, it is respectfully submitted that the present application is in condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. CODO-45537.

Respectfully submitted,
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